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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/716,555

11/20/2003

David Joseph Preskar

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05/30/2007

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

MOHANDESI, JILA M

ART UNIT

PAPER NUMBER

3728

NOTIFICATION DATE

DELIVERY MODE

05/30/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/716,555

Applicant(s)

PRESKAR ET AL.

Examiner

Jila M. Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE 03/05/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-29,31-33 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,12,15,16,21-24,26,29 and 31-37 is/are rejected.
- 7) ☒ Claim(s) 9-12,15,16,21-24,26,29,31-33 and 35-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/05/2007 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Dixon 5,544,431. Dixon '431 discloses all the limitations of the claims including the following: an athletic shoe 10; a sole assembly 18; a cushioning arrangement 24, 30, 32, 34, 50, 42, 28, 52 disposed within said sole assembly; the cushioning arrangement including at least two cushioning elements 28, 30, 32, 34 (inasmuch as the cushioning elements have been defined in the claims, wall areas 24, 38 and 42 can be construed as cushioning elements); a first of the cushioning elements disposed on a medial side of said shoe in a heel region of said shoe (see Figures 1-3) and a second of the cushioning elements provided on a lateral side of said shoe in said heel region (see

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Figures 1-3); a stiffening spring 24, 38, 42 at least partially surrounding each cushioning element; said stiffening spring having a stiffness greater than each cushioning element (supports the compression of each cushioning element); a central cushioning arrangement 50, 52 disposed in a central portion of said heel region (see Figure 3); the central cushioning arrangement including a plurality of cushioning ribs 50, 52 spaced apart from each other in a lengthwise direction of the shoe (see Figure 2, forward end of 50 is one rib, near front of heel, rearward end of 50 is another rib that are spaced lengthwise of the shoe, from each other) and extending in a widthwise direction of said shoe (see Figure 2); a first set of cushioning elements 28, 30 disposed between said first cushioning arrangement and said central cushioning arrangement, and a second set of cushioning elements 32, 34 disposed between said second cushioning arrangement and said central cushioning arrangement.

4. Claims 1, 5 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kilgore et al. (US 5,343,639). Kilgore discloses the limitations as follows: a sole assembly 14; a cushioning arrangement 24, 26, 28 and 30 disposed within said sole assembly; at least one cushioning element 24; a stiffening spring 26, 28 and 30 at least partially surrounding the at least one cushioning element; the stiffening spring has a stiffness greater than the at least one cushioning element (see col. 4, line 32-45), a portion of said at least one cushioning element is disposed adjacent to a periphery of said shoe (see Figure 22-2c) and said stiffening spring at least partially defines an aperture (see Figure 2c, spring 26, 28, and 30 defines aperture); the at least one cushioning element is disposed in said aperture such that said at least one cushioning

element can be seen and touched from an exterior of said shoe after completion of assembly of the shoe (see Figure 1), a first plurality of cushioning elements are disposed in said aperture, and a space that can be seen and touched from an exterior of said shoe after completion of assembly of the shoe provided between adjacent ones of the first plurality of elements.

5. Claims 1, 5-7, 21-22 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hagg et al. (US 4,262,433). Hagg discloses an athletic shoe comprising: a sole assembly 12; a plurality of cushioning assembly (cushioning element 34 and stiffening spring 42, see figure 5 embodiment), disposed on a medial side of said shoe; a second cushioning assembly disposed adjacent to first cushioning assembly on a lateral side of said first cushioning assembly, said first cushioning assembly and said second cushioning assembly at substantially a same position along a length direction of said shoe; a third cushioning assembly on a lateral side of said second cushioning assembly; a fourth cushioning assembly disposed such that said third cushioning assembly is disposed between said second and forth cushioning assemblies; and a fifth cushioning assembly disposed on a lateral side of said shoe. See Figures 1-3 embodiments.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 8, 15-16, 23-24, 29, 31-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagg in view of Preman et al. 5,224,280. Hagg as described above discloses all the limitations of the claims except for stiffening spring having a curved top disposed above the first plurality of cushioning elements. Preman et al. '280 teaches that the top wall 13 of a stiffening spring 4 can be curved to help absorb the impact of the user's foot with the ground. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the top wall of the stiffening spring of Hagg curved, as taught by Preman et al. '280, to aid in cushioning the impact of the user's foot with the ground.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 16 above in view of Dixon 5,544,431. The references as applied to claim 16 above disclose all the limitations of the claims except for the central cushioning portion in the heel with ribs. Dixon '431 teaches that a central cushioning arrangement can have ribs 52 extending in a widthwise direction to aid in cushioning the impact of the user during use as well as to keep the other cushioning elements supported in a vertical manner. Therefore, it would have been obvious, to one of

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ordinary skill in the art at the time the invention was made, to place a central cushioning arrangement with widthwise extending ribs, such as that taught by Dixon '431, in the central area of the cushioning arrangement of the references as applied to claim 16 above, to aid in cushioning the impact of the user's foot with the ground as well as support the other cushioning elements.

Allowable Subject Matter

10. Claims 9-11, 13-14, 17-20, 25, 27-28, 38 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments with respect to claims 1, 5-8, 12, 15-16, 21-24, 26, 29 and 31-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are footwear analogous to applicant's instant invention.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
May 21, 2007